

respectfully requested that the definiteness rejection be withdrawn as to claim 11, since it is respectfully submitted that claim 11 is allowable.

Claims 1 to 4 and 9 to 11 were rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 6,275,765 (Divljakovic '765), U.S. Patent No. 6,285,947 (Divljakovic '947) or U.S. Patent No. 6,380,659 (Rueger).

To anticipate a claim under § 102, a single prior art reference must identically describe each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged as in the claim. Lindeman, 703 F.2d 1458 (emphasis added).

Claim 1 recites that the predefined voltage is monitored "across at least one of the piezoelectric actuator and the high voltage supply lead in a time period in which the piezoelectric actuator is charged." Claim 11 recites that the voltage is detected "across at least one of the piezoelectric actuator and a supply lead of the piezoelectric actuator in a time period in which the piezoelectric actuator is charged."

Both of the Divljakovic references state that "by periodically measuring the power spectral density (PSD) of the selected indicator parameter, a reference profile, or magnitude, can be developed," and further state that the "reference profile 10 is then stored for later comparison to periodically update current magnitudes of the PSD." (Divljakovic references, col. 7, lines 14 to 32).

Hence, claim 1 and claim 11 are not identically described (or suggested) by the Divljakovic references because in both claims 1 and 11, the voltage is monitored or detected "across at least one of the piezoelectric actuator and the high voltage supply lead in a time period in which the piezoelectric actuator is charged." It is therefore respectfully submitted that the Divljakovic references do not identically describe (or suggest) claims 1 and 11.

Claims 2 to 4 and 9 to 10 depend from claim 1, and are therefore allowable for the same reasons as claim 1.

As regards the Rueger reference, the present application was filed in the United States on **July 9, 2001**, and claims foreign priority to German Patent Application No. 100 33 196.3, filed in the Federal Republic of Germany on **July 7, 2000**. A certified English translation of the German priority application accompanies this response. Accordingly, Rueger is not prior

art under 35 U.S.C. § 102(e). It is therefore respectfully submitted that claims 5 to 8 are allowable over the Rueger reference, since it is not prior art under 35 U.S.C. § 102(e).

With respect to paragraphs five (5), claims 5 to 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over Divljakovic '765, Divljakovic '947 or Rueger.

For a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim, and the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. § 2142. To establish a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. § 2143. It is respectfully submitted that these criteria for obviousness are not met here.

Claims 5 to 8 depend on claim 1, so that all the features of claim 1 that are not described (or suggested) by the Divljakovic references are also not taught or suggested with respect to claims 5 to 8. Accordingly, claims 5 to 8 are not rendered obvious for at least the same reasons as claim 1, and withdrawal of the obviousness rejections of claims 5 to 8 is therefore respectfully requested.

As explained above, the Rueger reference is not prior art under 35 U.S.C. § 102(e), and therefore claim 5 to 8 are allowable over that reference.

In summary, it is respectfully submitted that all of claims 1 to 11 are allowable for the foregoing reasons.

CONCLUSION

In view of all of the above, it is believed that the rejections have been obviated, and that claims 1 to 11 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,

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AMENDMENT VERSION WITH MARKINGS

IN THE CLAIMS:

Without prejudice, please amend claim 11 as follows:

11. (Twice Amended) A device, comprising:

a voltage source;

a program-controlled computer;

at least one switch that is connected in series with the voltage source and a piezoelectric actuator of an injector; and

a measurement unit that detects a voltage across at least one of the piezoelectric actuator and a supply lead of the piezoelectric actuator [during an injection phase] in a time period in which the piezoelectric actuator is charged; wherein:

the measurement unit detects a first voltage across at least one of the piezoelectric actuator and the supply lead of the piezoelectric actuator at a beginning of an injection pause.

the measurement unit detects a second voltage across at least one of the piezoelectric actuator and the supply lead of the piezoelectric actuator at an end of the injection pause.

the program-controlled computer generates a voltage difference [from at least two detected voltage values] between the first voltage and the second voltage and compares the voltage difference to a predefined threshold, and

when a value of the predefined threshold is exceeded the program-controlled computer at least one of shuts off the voltage source, discharges the piezoelectric actuator, and produces a warning signal.